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EXAMINER

TRAN, CON P

| ART UNIT | PAPER NUMBER |
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2644

DATE MAILED: 07/14/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

1

Office Action Summary

Application No.

09/239,414

Applicant(s)

UMSTETTER ET AL.

Examiner

Con P. Tran

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 4, 7-8, 17, and 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Sells et al. U.S. Patent 5,471,522.

Regarding **claim 1**, Tombetti teaches a method for extending a telephone's capability (see Fig. 2, 3, 5, and respective portions of the specification) comprising steps of:

360 - Fig 2

enabling a telephone to store call-related data in memory (360) located within the telephone (see col. 8, lines 29-35);

receiving first call-related data at the telephone (see col. 5, lines 50-65 and col. 3, lines 32-49);

recognizing that the first call-related data is to be stored in memory (see col. 8, lines 29-35);

determining, within the telephone, whether the first call-related data will be stored in the telephone memory or the computer memory (see col. 3, lines 32-49 and col. 5, lines 50-65); and

storing the first call-related data in the telephone memory or the computer memory based upon the determination (see col. 3, lines 32-49; col. 5, lines 50-65 and col. 8, lines 29-35);

enabling a computer to store the call-related data in memory located within the computer (see col. 3, lines 32-49);

However, Tombetti reference does not explicitly disclose to alternatively store the call-related data in memory located within the computer. Thus one of ordinary skill would have been motivated to seek an embodiment in order to provide an actual working arrangement taught by Tombetti. Such embodiments would have been any known computer system such as one of Sells et al. in the same field of endeavor.

Sells et al. teaches a telephone line coupled to a personal computer to share the telephone line in which a telephone manager program opens a communication path for the telephone line through a telephony application interface and senses a ring for the incoming call over the telephone line. If a media mode (e.g., answering machine) for the incoming call is known, then the telephone manager program answers the incoming call and passes the telephone line to a telephony application program for the media mode (col. 2, lines 35-50; Fig. 1, 2, 3, and respective portions of the specification), thus alternatively store the call-related data in memory located within the computer (i.e., voice store 108 as automatic telephone answering machine; col. 3, lines 59-65; col. 4,

lines 39-43) in order to transfer control of the telephone line to the appropriate telephony application program (see col. 8, lines 59-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Sells et al. to Tombetti in order to transfer control of the telephone line to the appropriate telephony application program, as suggested by Sells et al. in column 8, lines 59-62.

Regarding **claim 4**, Tombetti further teaches the method as claimed in claim 1 (see Fig. 2, 3, 5, and respective portions of the specification), wherein the telephone is enabled to perform telephone functions independently of the computer (see col. 3, lines 32-49 and col. 5, lines 50-65).

Regarding **claim 7**, Tombetti in view of Sells et al. teaches a method as claimed in claim 1 further including steps of:

enabling a first processor (152) located within the telephone to process data received at the telephone (see Tombetti, Fig. 3, col. 6, lines 10-18);

enabling a second processor located within the computer to process data received at the telephone (see Tombetti, col. 3, lines 32-49);

recognizing that the first call-related data received at the telephone is to be processed (see Sells, col. 5, lines 5-18); and

determining, within the telephone, whether the first call-related data will be processed by the first processor or the second processor (see Tombetti, col. 3, lines 32-

49 and col. 5, lines 50-65), the telephone thereby controlling the first call-related towchich of two structurally separate components will perform processing thereon.

Regarding **claim 8**, Sells et al. teaches the method as claimed in claim 1 (see Fig. 1, 4, and respective portions of the specification) further including a step of utilizing a processor of the computer to process at least a portion of the first call-related data in response to instructions from the telephone (see col. 4, line 65 - col. 5, line 14).

Regarding **claim 17**, Tombetti teaches a method for extending a telephone's capability (see Fig. 2, 3, 5, and respective portions of the specification) comprising steps of:

enabling a first processor (152) resident in a telephone to process data received at the telephone (see col. 6, lines 10-18);

enabling a second processor resident in a computer to process data received at the telephone (see col. 3, lines 32-49);

receiving call-related data at the telephone (see col. 5, lines 50-65 and col. 3, lines 32-49);

determining, using automated processing capabilities of the telephone (col. 6, lines 34-40), whether the call-related data will be processed in the first processor or the second processor (see col. 3, lines 32-49, and col. 5, lines 50-65) including basing said determination upon automated processing performed by the telephone; and

processing the call-related data in either the telephone or the computer based upon the determination (see col. 3, lines 32-49; col. 5, lines 50-65) made using the automated capabilities (col. 6, lines 34-40).

However, Tombetti reference does not explicitly disclose a step of recognizing that the call-related data required further processing. Thus one of ordinary skill would have been motivated to seek an embodiment in order to provide an actual working arrangement taught by Tombetti. Such embodiments would have been any known computer system such as one of Sells et al. in the same field of endeavor.

Sells et al. teaches a step (see Fig. 1, 5, and respective portions of the specification) of recognizing that the call-related data required further processing (see col. 5, lines 5-18) in order to transfer control of the telephone line to the appropriate telephony application program (see col. 8, lines 59-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti reference a step of recognizing that the call-related data required further processing as taught by Sells et al. since such combination would have transferred control of the telephone line to the appropriate telephony application program as suggested by Sells et al. in column 8, lines 59-62.

Regarding **claim 19**, Tombetti in view of Sells et al. teaches a method as claimed in claim 18 (see Fig. 2, 3, 5, and respective portions of the specification) including steps of:

enabling the telephone to store data received at the telephone in memory located within the telephone (see Sells, col. 8, lines 29-35);

enabling the computer to store data received at the telephone in memory (360) located within the computer (see Sells, col. 3, lines 39-65 and col. 4, lines 48-54);

recognizing that the received call-related data is to be stored in memory (see Sells, col. 4, lines 3-6);

determining, within the telephone, whether the call-related data will be stored in the telephone memory or the computer memory (see Tombetti, col. 3, lines 32-49 and col. 5, lines 50-65); and

storing the call-related data in the telephone memory or the computer memo based upon the determination (see Tombetti, col. 3, lines 32-49; col. 5, lines 50-65 and col. 8, lines 29-35).

Regarding **claim 20**, Tombetti further teaches the steps of determining are performed by an application programming interface residing within the telephone (see col. 4, lines 16-35).

3. **Claims 2-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Sells et al. U.S. Patent 5,471,522, and further in view of Dunn et al. U.S. Patent 5,495,528.

Regarding **claim 2**, Sells et al. further teaches a step of establishing (see Fig. 1 and respective portions of the specification) a direct data connection between the telephone and the computer (see col. 3, lines 53-58). However, Tombetti in view of Sells et al. does not explicitly show the telephone and the computer being structurally separate components.

Thus one of ordinary skill would have been motivated to seek a step of establishing a direct data connection in which the telephone and the computer being structurally separate components as step taught by Sells. Such method would have been any known telephone control interface such as one of Dunn et al. in the same field of endeavor.

Dunn et al. teaches a step of establishing (see Fig. 1 and respective portions of the specification) a direct data connection between the telephone and the computer, the telephone and the computer being structurally separate components (see col. 4, lines 4-25).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include within the Tombetti in view of Sells et al. a step of establishing a direct data connection between the telephone and the computer, the telephone and the computer being structurally separate components as taught by Dunn et al. in col. 4, lines 4-25 in order to selectively provide a computer control to a digital feature telephone as suggested by Dunn et al. in column 2, lines 44-45.

Regarding **claim 3**, Sells et al. further teaches the method as claimed in claim 2 (see Fig. 1 and respective portions of the specification) wherein the telephone and the computer are located within a common workspace, the step of establishing the direct data connection being independent of providing connectivity for receiving the first call-related data (see col. 3, lines 47-52).

4. **Claims 5-6, 9 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Sells et al. U.S. Patent 5,471,522, and further in view of Kikinis et al. U.S. Patent 5,799,068.

Regarding **claim 5**, Tombetti in view of Sells et al. teaches a method as claimed in claim 1 wherein the step of determining includes steps of:

monitoring storage availability within the telephone memory (see Tombetti col. 8, lines 1-8).

However, Tombetti in view of Sells et al. does not explicitly disclose:

comparing the monitored storage availability to a storage threshold that is related to the telephone memory; and

storing the first call-related data in the computer memory when the storage threshold related to the telephone memory is exceeded.

In the same field of endeavor, Kikinis et al. teaches steps of (see Fig. 3, 13, 14, and respective portions of the specification):

comparing the monitored storage availability to a storage threshold that is related to the telephone memory (see col. 2, lines 50-64 and col. 16, lines 11-21); and
storing the first call-related data in the computer memory when the storage threshold related to the telephone memory is exceeded (see col. 2, lines 50-64 and col. 16, lines 11-21);
in order to add digital telephone capability to the computer (see col. 3, lines 20-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti in view of Sells et al. reference steps of:

comparing the monitored storage availability to a storage threshold that is related to the telephone memory (see col. 2, lines 50-64 and col. 16, lines 11-21); and
storing the first call-related data in the computer memory when the storage threshold related to the telephone memory is exceeded (see col. 2, lines 50-64 and col. 16, lines 11-21);
as taught by Kikinis et al. since such combination would have added digital telephone capability to the computer as suggested by Kikinis et al. in column 3, lines 20-21.

Regarding **claim 6**, Kikinis further teaches a step (see Fig. 13, and respective portions of the specification) of retrieving call-related data from the compute to the telephone in response to signals from the telephone (see col. 12, lines 25-38).

Regarding **claim 9**, Kikinis further teaches a step (see Fig. 3, and respective portions of the specification) of establishing a data connection between the telephone and the computer by connecting the telephone separately to a telephone network and to the computer (see col. 5, lines 54-61).

Regarding **claim 18**, Tombetti in view of Sells et al. teaches a method as claimed in claim 17. Sells et al. further teaches the computer are structurally separate components (Fig. 1; col 3, lines 47-58).

However, Tombetti in view of Sells et al. does not explicitly disclose:

a step of establishing a direct data connection between the telephone and the computer, wherein the telephone and the computer are located within a common workspace and wherein the telephone is configured to perform telephone functions independently of the computer.

In the same field of endeavor, Kikinis et al. teaches a step of (see Fig. 1 and respective portions of the specification) establishing a direct data connection between the telephone and the computer, wherein the telephone and the computer are located within a common workspace and wherein the telephone is configured to perform telephone functions independently of the computer (see col. 3, lines 47-52) in order to add digital telephone capability to the computer (see col. 3, lines 20-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti in view of Sells et al. reference steps of:

establishing a direct data connection between the telephone and the computer, wherein the telephone and the computer are located within a common workspace and wherein the telephone is configured to perform telephone functions independently of the computer (see col. 3, lines 47-52) as taught by Kikinis et al. since such combination would have added digital telephone capability to the computer as suggested by Kikinis et al. in column 3, lines 20-21.

5. **Claims 10 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Kikinis et al. U.S. Patent 5,799,068.

Regarding **claim 10**, Tombetti teaches an apparatus for extending a telephone's capability (see Fig. 2, 3, 5, and respective portions of the specification) comprising:

means (communication module 156), located within the telephone, for receiving data from a telephone network (see col. 7, lines 21-25);

means (additional memory 360), located within the telephone, for storing the data received from the telephone network (see col. 8, lines 29-35);

However, Tombetti reference does not explicitly disclose:

means, operatively associated with the means for receiving, for enabling the telephone to automatically determine without user input whether the data received at the telephone will be maintained at the telephone or transferred to a computer; and

means, operatively associated with the telephone, for transferring the data between the telephone and the computer, wherein the means for enabling and the

means for transferring are cooperative to store the data at only one of the telephone and the computer. Thus one of ordinary skill would have been motivated to seek an embodiment in order to provide an actual working arrangement taught by Tombetti. Such embodiments would have been any known computer system such as one of Sells et al. in the same field of endeavor.

Kikinis et al. teaches apparatus (see Fig. 3, 13, 14, and respective portions of the specification) comprising:

means, operatively associated with the means for receiving, for enabling the telephone (smart phone) to automatically determine without user input (col. 17, lines 54-67) whether the data received at the telephone will be maintained at the telephone or transferred to a computer (see col. ⁵3, lines 54-67 and col. 15, line 60 - col. 16, line 21); and

means, operatively associated with the telephone, for transferring the data between the telephone and the computer (see col. 3, lines 54-67 and col. 15, line 60 - col. 16, line 21), wherein the means for enabling and the means for transferring are cooperative to store the data at only one of the telephone and the computer (i.e., data and program transfer between the host and μ PDA; col. 16, lines 11-21) in order to add digital telephone capability to the computer (see col. 3, lines 20-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Kikinis et al. to Tombetti in order to add digital telephone capability to the computer as suggested by Kikinis et al. in column 3, lines 20-21.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti reference apparatus comprising:

means, operatively associated with the means for receiving, for enabling the telephone (smart phone) to automatically determine without user input (col. 17, lines 54-67) whether the data received at the telephone will be maintained at the telephone or transferred to a computer (see col. 2, lines 50-64 and col. 15, line 60 - col. 16, line 21); and

means, operatively associated with the telephone, for transferring the data between the telephone and the computer (see col. 2, lines 50-64 and col. 15, line 60 - col. 16, line 21), as taught by Kikinis et al., since such combination would have added digital telephone capability to the computer as suggested by Kikinis et al. in column 3, lines 20-21.

Regarding **claim 16**, Tombetti in view of Kikinis et al. further teaches an apparatus as claimed in claim 10 including:

means (process module 152), located within the telephone, for processing the data received from the telephone network (see Tombetti, Fig. 3, col. 6, lines 10-18);

means (i.e., processing data), located within the computer, for processing the data received from the telephone (see Tombetti, col. 3, lines 32-49), the processing means of said computer (not shown) having superior processing capabilities as

compared to said processing means of said telephone (see Tombetti, col. 3, lines 32-49; col. 4, lines 15-35); and

means (ASIC 24), located within the telephone, for determining whether the data received at the telephone from the telephone network will be processed within the telephone processing means or the computer processing means (see Kikinis col. 6, lines 29-38).

6. **Claims 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Kikinis et al. U.S. Patent 5,799,068 and further in view of Sells et al. U.S. Patent 5,471,522.

Regarding **claim 11**, Tombetti in view of Kikinis et al. teaches an apparatus as claimed in claim 10. However, Tombetti in view of Kikinis et al. does not explicitly disclose:

means, located within the computer, for storing the data received from the telephone; and

means, located within the telephone, for determining whether data received at the telephone from the telephone network will be stored within the telephone storage means or the computer storage means.

In the same field of endeavor, Sells et al. teaches an apparatus including (see Fig. 1, 2, 3, and respective portions of the specification):

means (memory subsystem 31), located within the computer, for storing the data received from the telephone (see col. 3, lines 59-65); and

means (DSP software 120), located within the telephone, for determining whether data received at the telephone from the telephone network will be stored within the telephone storage means or the computer storage means (see col. 3, lines 59-65 and col. 4, lines 48-54);
in order to transfer control of the telephone line to the appropriate telephony application program (see col. 8, lines 59-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti in view of Kikinis et al. reference an apparatus including means (memory subsystem 31), and means (DSP software 120), as taught by Sells et al., since such combination would have transferred control of the telephone line to the appropriate telephony application program as suggested by Sells et al. in column 8, lines 59-62.

Regarding **claim 12**, Sells et al. further teaches an apparatus as claimed in claim 10 (see Fig. 1 and respective portions of the specification) wherein the telephone is connected separately to the telephone network and the computer (see col. 3, lines 47-52).

7. **Claims 13-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Kikinis et al. U.S. Patent 5,799,068 further in

view of Sells et al. U.S. Patent 5,471,522, and further in view of Yeh et al. U.S. Patent 6,366,653.

Regarding **claim 13**, Tombetti in view of Kikinis, and further in view of Sells teaches an apparatus as claimed in claim 12.

However, the Tombetti, Kikinis, and Sells in combination fails to clearly teaches an apparatus wherein the computer lacks computer telephony capability.

In the same field of endeavor, Yeh et al. teaches a computer lacks computer telephony capability (see col. 1, lines 30-34) in order to provide various telephone functions on the computer with user friendly interfaces using programmable software, and computer and telephone hardware (see col. 1, lines 50-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti, Kikinis, and Sells in combination an apparatus wherein the computer lacks computer telephony capability as taught by Sells et al. since such combination would have provided various telephone functions on the computer with user friendly interfaces using programmable software, and computer and telephone hardware as suggested by Yeh et al. in column 1, lines 50-53.

Regarding **claim 14**, Kikinis et al. further teaches an apparatus wherein the means for enabling is located within the telephone (see col. 2, lines 50-64 and col. 15, line 60 – col. 16, line 21).

Regarding **claim 15**, Kikinis et al. further teaches an apparatus wherein the means for enabling includes an application programming interface resident within the telephone (see col. 2, lines 50-64 and col. 15, line 60 – col. 16, line 21).

Response to Arguments

8. Applicant's arguments filed on April 14, 2003 have been fully considered but they are not persuasive.

9. Applicant asserts on pages 12-13:

“.... Since the NPDA does not have superior storage or superior processing capability, the combination of Tombetti and Kikinis et al. does not render amended claims 10 and 16 obvious under Section 103(a).”

Examiner respectfully disagrees. As discussed above in the rejections, Tombetti in view of Kikinis et al. teaches the processing means of said computer (not shown) having superior processing capabilities as compared to said processing means of said telephone (see Tombetti, col. 3, lines 32-49; col. 4, lines 15-35). Therefore, claims 10 and 16 are seen to be properly rejected and are being maintained by the Examiner.

Applicant asserts on pages 6-7:

“The Office action cites lines 32-49 in column 3 of Tombetti. This portion of the patent states that the telephone 10 has limited functionality in accessing an online service, so that a separate computer is frequently used to send and receive data over a communication line 14.... However,

the patent does not state that the computer supports the telephone 10. More importantly, the patent does not state that the telephone determines data storage of the computer (claim 1) or data processing by the computer (claim 17) . . .

Since column 3, lines 59-65 of Sells et al. identify components of the computer, the cited portion does not teach or suggest enabling a telephone to store call related data in memory located within the telephone...”

Examiner respectfully disagrees. As discussed above in the rejections, Tombetti in view of Sells et al. teaches determining, within the telephone, whether the first call-related data will be stored in the telephone memory or the computer memory in col. 3, lines 32-49 and col. 5, lines 50-65; and processing the call-related data in either the telephone or the computer based upon the determination in col. 3, lines 32-49; col. 5, lines 50-65 (e.g., the functionality of the telecommunications terminal 10 is severely limited. Therefore, a computer is frequently used to send or receive data over a telecommunications terminal line and carry out other complex processes). Accordingly, claims 1 and 17 are seen to be properly rejected and are being maintained by the Examiner.

Applicant further asserts on page 7:

“.... Thus, the prior art teaches away from the claimed invention.”

Examiner respectfully disagrees. There is no specific recitation in Tombetti nor in Sells et al. that says that the computer and the telephone could not obvious function together at the time of the invention was made.

10. Applicant asserts on page 10:

".... The Office action asserts that modifying Tombetti to incorporate teachings of Kikinis et al. would be obvious, since the combination would add digital telephone capability. However, as specifically stated in column 5, lines 50-52 of Tombetti, the system 100 of Fig. 2 may be provided with digital telephone capability. Since the Tombetti system is configurable to include digital telephone capability, it would not be obvious to disregard the principle of operation of the Tombetti system to "add" digital telephone capability..."

Examiner respectfully disagrees. In column 5, line 57, Tombetti discloses "preferably an ISDN". Thus the system 100 may not be provided with digital telephone capability yet.

11. Applicant asserts on page 11:

".... Applicants respectfully request that the Examiner provide an explanation as to why it would be obvious to greatly reduce the capabilities of the Tombetti system 100. It is submitted that the issue of disregarding critical teachings of Tombetti is not rendered "moot" by the citation of the Dunn et al. patent as applied to unrelated claims (i.e., claims 2 and 3). Moreover, as asserted on page 11 of the previously filed amendment, the Office action evidences a fundamental misunderstanding of the teachings of Yeh et al. It is inaccurate to state that Yeh et al. teaches that a computer lacks computer telephony capability in order to provide various telephone functions on the computer with user friendly interfaces using programmable software, and computer and telephone hardware..."

Examiner respectfully explains. In column 4, lines 17-18, Tombetti discloses "is relatively low cost but can be expanded to provide new functions". Thus the system 100 may not have all possible computer telephone capability yet.

12. Applicant asserts on page 12:

“.... That is, there is no motivation for attaching a separate digital feature phone to the Tombetti patent, which may function itself as a digital feature telephone...”

Examiner respectfully disagrees. As discussed above in the rejections, Dunn et al. provide motivation in column 2, lines 44-45 for Tombetti in view of Sells et al. and further in view of Dunn et al.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Con P. Tran whose telephone number is (703) 305-2341. The examiner can normally be reached on M - F (8:30 AM - 5:00 PM).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office at telephone number (703) 306-0377.

cpt CPJ
July 3, 2003



FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600